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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,660	01/14/2004	Markus Allemann	0212.66402	4465
24978 7590 05/05/2008 GREER, BURNS & CRAIN 300 S WACKER DR 25TH FLOOR CHICAGO, IL 60606				
EXAMINER				
GATES, ERIC ANDREW				
ART UNIT		PAPER NUMBER		
3726				
MAIL DATE		DELIVERY MODE		
05/05/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/757,660

Applicant(s)

ALLEMANN ET AL.

Examiner

Eric A. Gates

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the Appeal Brief filed on 3 April 2008, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/David P. Bryant/
Supervisory Patent Examiner, Art Unit 3726

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5, 10, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Crutchfield (U.S. Patent 4,866,319).
4. Regarding claim 1, Crutchfield discloses a control mechanism 28/66/76 for a rotary hand tool 10 having a generally cylindrical housing 12 in which a drive motor 26 is located, the housing having a generally tapered nose portion 14 at an end from which a motor output shaft 24 extends (see figure 2, shaft 24 extends (primary definition "to stretch out", per Oxford online dictionary) from motor 26 in the nose portion) and a grip portion 14 around which an operator can wrap a hand during operation of the tool and within which portion the motor is housed, said control mechanism 28/66/74 being a part of the tool and located substantially within the housing thereof and comprising: an electrical control circuit 74 contained entirely within said housing, said circuit controlling the application of power to and the operation of the motor, including supplying current to the motor; and a light touch switch 30 (said switch 30 only including the switch button device 30 and not the electrical elements of microswitch 78) having at least a first position (not pushed) and a second position (pushed) (see column 4, lines 46-68) coupled to said electrical control circuit (mechanically coupled through contact with microswitch 78) for selectively enabling or disabling said control circuit to turn the motor on and off, wherein said motor current does not flow through said switch 30 (said switch 30 only including the switch button device 30 and not the electrical elements of microswitch 78); wherein said switch 30 is disposed on the tapered nose portion 14 of the rotary hand tool such that an operator can actuate said switch without altering the operator's grip on the tool.

5. Regarding claim 2, Crutchfield discloses wherein said switch 30 is configured to be generally rectangular (exterior portion 88 as viewed from above in figure 1).
6. Regarding claim 3, Crutchfield discloses wherein said switch 30 has a predetermined thickness (it is inherent that the switch would be made with a predetermined thickness)
7. Regarding claim 4, Crutchfield discloses wherein said first position disables said electrical control circuit and said second position enables said electrical control circuit (see column 3, lines 41-48).
8. Regarding claim 5, Crutchfield discloses wherein the tapered nose portion on which said switch 30 is disposed generally corresponds to a location of the operator's index finger when grasping the tool (see figure 1).
9. Regarding claim 10, Crutchfield discloses an apparatus 28 for selectively controlling power applied to and the operation of the motor 26 of a rotary hand tool 10 having a generally cylindrical housing 12 that includes a generally tapered nose portion 14 that has a gradually reduced circumference toward an end from which an output shaft 24 extends (see figure 2, shaft extends (definition "to stretch out", per Webster's online dictionary)), and a grip portion 14 around which an operator wraps a hand during operation of the tool, said apparatus comprising: electrical control circuitry 28/66/74 for controlling power, including motor current that is applied to the motor, said electrical circuitry being a part of the tool and located entirely within the housing; a switch 30 (said switch 30 only including the switch button device 30 and not the electrical elements of microswitch 78) having a switch button 88 and containing at least a pair of switch

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contacts 80/86 that are selectively opened and closed responsive to actuation of said switch button 88, said switch 30 being operatively connected to said control circuitry to control the operation of the motor (switch 30 is mechanically connected to the control circuitry through contact with microswitch 78), including the application of motor current to the motor, wherein said motor current does not flow through said switch 30 (said switch 30 only including the switch button device 30 and not the electrical elements of microswitch 78), said switch 30 being a part of the tool 10 and located substantially within the tapered nose portion 14 thereof; and a cavity (see figure 2) disposed in the nose portion of the tool that is configured to receive at least a portion of said switch 30 and permit actuation of said switch button 88.

10. Regarding claim 12, Crutchfield discloses that the outer surface of said switch button 88 is generally coextensive with the outer surface of said nose portion 14 (see figure 1).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crutchfield in view of Von Hollen (U.S. Patent 3,640,635).

13. Regarding claim 6, Crutchfield discloses the invention substantially as claimed, except Crutchfield does not disclose a layer of flexible grip material surrounding at least a portion of the nose portion.

Von Hollen teaches the use of a layer of rubber 11 surrounding the portion of the nose portion in which a switch 55-49 is disposed, abutting said switch when the flexible material is compressed, for the purpose of providing a yielding surface in the nose portion of the tool. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to have combined the tool of Crutchfield with the flexible grip material of Von Hollen in order to have a tool with a more comfortable grip.

14. Regarding claims 7-9, the modified invention of Crutchfield discloses the invention substantially as claimed.

15. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crutchfield in view of Von Hollen (U.S. Patent 3,640,635).

16. Regarding claim 11, Crutchfield discloses the invention substantially as claimed, except Crutchfield does not disclose a layer of grip material surrounding at least a portion of the grip portion in which said switch is located.

Von Hollen teaches the use of a layer of rubber 11 surrounding the portion of the nose portion in which a switch 55-49 is disposed, abutting said switch when the flexible material is compressed, for the purpose of providing a yielding surface in the grip portion of the tool. Therefore it would have been obvious to one having ordinary skill in

the art at the time the invention was made to have combined the tool of Crutchfield with the flexible grip material of Von Hollen in order to have a tool with a more comfortable grip.

Response to Arguments

17. Applicant's arguments, see page 9, filed 3 April 2008, with respect to the rejection(s) of claim(s) 10 and 12 under 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Crutchfield.

18. Applicant's argument that the switch button device 30 of Crutchfield is not a switch as claimed in claims 1 and 10 is not persuasive. Webster's Online Dictionary defines a switch as "a device for making, breaking, or changing the connections in an electrical circuit". This definition and the claim language do not require that the switch be a part of the electrical linkage, and as such the mechanical switch 30 of Crutchfield meets the requirements of the claim. Applicant's arguments state that the switch button device 30 is just a mechanical linkage, but they do not state how the claim language does not allow for this interpretation, which was based on the dictionary definition above.

19. Applicant's additional arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

20. For the reasons as set forth above, the rejections are maintained.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Gates whose telephone number is (571)272-5498. The examiner can normally be reached on Mon-Thurs 8:45 - 6:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. A. G./
Examiner, Art Unit 3726
21 April 2008

/David P. Bryant/
Supervisory Patent Examiner, Art Unit 3726